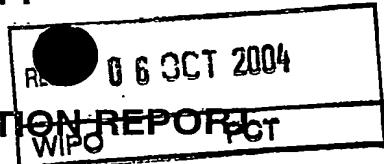


PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION
(PCT Article 36 and Rule 70)

23 DEC 2004

Applicant's or agent's file reference 08-892370WO	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. PCT/CA 03/00964	International filing date (day/month/year) 27.06.2003	Priority date (day/month/year) 28.06.2002
International Patent Classification (IPC) or both national classification and IPC A01H5/00		
Applicant UNIVERSITY OF GUELPH et al.		

<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 6 sheets, including this cover sheet.</p> <p><input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of 4 sheets.</p>
<p>3. This report contains indications relating to the following items:</p> <ul style="list-style-type: none"> I <input checked="" type="checkbox"/> Basis of the opinion II <input type="checkbox"/> Priority III <input checked="" type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability IV <input type="checkbox"/> Lack of unity of invention V <input checked="" type="checkbox"/> Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement VI <input type="checkbox"/> Certain documents cited VII <input type="checkbox"/> Certain defects in the international application VIII <input type="checkbox"/> Certain observations on the international application

Date of submission of the demand 14.01.2004	Date of completion of this report 05.10.2004
Name and mailing address of the international preliminary examining authority: European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Burkhardt, P Telephone No. +49 89 2399-7456



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**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/CA 03/00964

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-36 as originally filed

Sequence listings part of the description, Pages

1-10 as originally filed

Claims, Numbers

1-20 received on 30.08.2004 with letter of 27.08.2004

Drawings, Sheets

1/13-13/13 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- the language of publication of the international application (under Rule 48.3(b)).
- the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- contained in the international application in written form.
- filed together with the international application in computer readable form.
- furnished subsequently to this Authority in written form.
- furnished subsequently to this Authority in computer readable form.
- The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- the description, pages:
- the claims, Nos.:
- the drawings, sheets:

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No.

PCT/CA 03/00964

5. This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

the entire international application,
 claims Nos. 1 - 20 (all partially)

because:

the said international application, or the said claims Nos. relate to the following subject matter which does not require an international preliminary examination (specify):
 the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (specify):
 the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
 no international search report has been established for the said claims Nos. 1 - 20 (all partially)

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/ or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

the written form has not been furnished or does not comply with the Standard.
 the computer readable form has not been furnished or does not comply with the Standard.

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1 - 20
	No: Claims	
Inventive step (IS)	Yes: Claims	
	No: Claims	1 - 20
Industrial applicability (IA)	Yes: Claims	1 - 20
	No: Claims	

2. Citations and explanations

see separate sheet

Re Item I

Basis of the report

The amended claims filed with the letter of 27.08.2004 are formally acceptable under Article 34(2)(b) PCT.

Re Item III

No opinion

1. In response to an invitation of the ISA to restrict the claims or pay additional search fees the applicant neither restricted the claims nor paid additional fees. Consequently, only invention 1 was searched and this report will also be limited to invention 1.
2. The reasons for the non-unity objection were as follows:

2.1 Article 3(4)iii PCT and Rule 13.2 PCT stipulate that where a group of inventions is claimed the requirements of unity shall be fulfilled only where there is a technical relationship among those inventions involving one or more of the same corresponding special technical features. "Special" technical features are those features that define a contribution which each of the inventions makes over the prior art.

2.2 The only corresponding technical feature linking the different groups of inventions is that they all relate to genes from *Medicago sativa* that are allegedly harvest-inducible. Such genes, however, are already known from the prior art (e.g. WO0173090). Therefore, this feature cannot provide a common inventive concept for potential inventions 1 - 3.

2.3 The applicant was requested to note that the alleged function of a gene, i.e. being harvest-inducible, is a non-distinctive characteristic and would not render the subject-matter of claim 1 novel over the prior art.

2.4 Consequently, there is lack of unity, and the different inventions not belonging to a common inventive concept, had been divided into different groups pursuant to Article 17(3)(a) PCT:

Invention 1 (Claims 1 - 26, all partially)

relating to a harvest-inducible cDNA (SEQ ID NO:1), the corresponding regulatory element (SEQ ID NO:4), a method for their isolation, vectors and plants containing said regulatory element and to methods for the production of heterologous proteins in plants employing said regulatory element.

Invention 2 (Claims 1 - 26, all partially)

relating to a harvest-inducible cDNA (SEQ ID NO:2), the corresponding regulatory element (SEQ ID NO:5), methods for their isolation, vectors and plants containing said regulatory element and to methods for the production of heterologous proteins in plants employing said regulatory element.

Invention 3 (Claims 1 - 26, all partially)

relating to a harvest-inducible cDNA (SEQ ID NO:3), the corresponding regulatory element (SEQ ID NO:6), methods for their isolation, vectors and plants containing said regulatory element and to methods for the production of heterologous proteins in plants employing said regulatory element.

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

The following documents (D) are referred to; the numbering is following the order of the International Search Report:

- D1 Ferullo *et al.*, 1996. Crop Sci 36:1011-1016.
- D2 Matz and Lukyanov, 1998. Nucl. Acids Res. 26:5537-5543.
- D3 Kuhn, 2001. Ann. Bot. 87:139-155.
- D4 WO-A-0173090 (Samuel Roberts Noble Foundation)

1. Article 33(2)(3) PCT (Novelty and inventive step)

1.1 Present claim 1 is directed to a regulatory element (SEQ ID NO:4) having

harvest-inducible regulatory activity.

1.2 It appears that subject-matter closely related to SEQ ID NO:4 could meet the requirements of Articles 33(2)(3) PCT as the prior art does not disclose or suggest a regulatory element of SEQ ID NO:4.

1.3 The claim, however, reads on to fragments or complement of fragments of SEQ ID NO:4, and to nucleic acids that hybridise to a fragment or complement of SEQ ID NO:4. Thus it relates to subject-matter that is neither sufficiently disclosed (Article 5 PCT) nor supported by the description (Article 6 PCT). In addition an undue burden is placed on others trying to establish the extent of protection and it would require undue experimentation to reduce the claimed subject-matter to practice (Article 5 PCT).

1.4 Moreover, the description and the prior art do not provide credible evidence that any fragment or complement of SEQ ID NO:4 or sequences hybridising to these fragments or complements would solve the technical problem, i.e. the provision a regulatory element having harvest-inducible regulatory activity. Present claim 1 does not meet the requirements of Article 33(3) PCT. The same holds true for dependent claims 2 - 20.

1.5 The applicant is requested to note that functional statements like "having harvest-inducible regulatory activity" do not correct this deficiency. The subject-matter of a claim should be defined in terms of technical features of the invention which would be a nucleic acid sequence that indeed possesses the claimed function.

THE EMBODIMENTS OF THE INVENTION IN WHICH AN EXCLUSIVE PROPERTY OF PRIVILEGE IS CLAIMED ARE DEFINED AS FOLLOWS:

1. A regulatory element selected from the group consisting of:

- i) SEQ ID NO:4, a complement thereof, a fragment of SEQ ID NO:4, a complement of a fragment of SEQ ID NO:4, a nucleic acid that hybridizes to SEQ ID NO:4 under stringent hybridization conditions, a nucleic acid that hybridizes to a complement of SEQ ID NO:4 under stringent hybridization conditions, a nucleic acid that hybridizes to a fragment of SEQ ID NO:4 under stringent hybridization conditions, or a nucleic acid that hybridizes to a complement of fragment of SEQ ID NO:4 under stringent hybridization conditions, having harvest-inducible regulatory activity;
- ii) SEQ ID NO:5, a complement thereof, a fragment of SEQ ID NO:5, a complement of a fragment of SEQ ID NO:5, a nucleic acid that hybridizes to SEQ ID NO:5 under stringent hybridization conditions, a nucleic acid that hybridizes to a complement of SEQ ID NO:5 under stringent hybridization conditions, a nucleic acid that hybridizes to a fragment of SEQ ID NO:5 under stringent hybridization conditions, or a nucleic acid that hybridizes to a complement of fragment of SEQ ID NO:5 under stringent hybridization conditions, having harvest-inducible regulatory activity; and
- iii) SEQ ID NO:6, a complement thereof, a fragment of SEQ ID NO:6, a complement of a fragment of SEQ ID NO:6, a nucleic acid that hybridizes to SEQ ID NO:6 under stringent hybridization conditions, a nucleic acid that hybridizes to a complement of SEQ ID NO:6 under stringent hybridization conditions, a nucleic acid that hybridizes to a fragment of SEQ ID NO:6 under stringent hybridization conditions, or a nucleic acid that hybridizes to a complement of fragment of SEQ ID NO:6 under stringent hybridization conditions, having harvest-inducible regulatory activity,

the stringent hybridization conditions comprising, hybridization overnight (12-24 hrs) at 42°C in the presence of 50% formamide, followed by washing, or 5X SSC at about 65°C for about 12 to about 24 hours, followed by washing in 0.1X SSC at 65°C for about one hour, wherein the regulatory element exhibits harvest-inducible activity.

2. A construct comprising said harvest-inducible regulatory element of claim 1, operably linked with a heterologous coding sequence of interest and a terminator region.
3. A construct comprising a heterologous coding sequence operably linked to the harvest-inducible regulatory element of claim 1, the harvest-inducible regulatory element further comprising a nucleotide sequence encoding a harvest-inducible protein or fragment thereof.
4. A vector comprising the DNA construct of claim 2.
5. A vector comprising the DNA construct of claim 3.
6. A plant, plant tissue, plant seed, plant cell, or progeny therefrom, comprising the construct of claim 2.
7. A plant, plant tissue, plant seed, plant cell, or progeny therefrom, comprising the construct of claim 3.
8. A method for production of a heterologous protein in a plant comprising:
 - i) providing a plant transformed with the construct of claim 2;
 - ii) growing the transformed plant; and
 - iii) harvesting the transformed plant thereby inducing expression of the heterologous protein.
9. The method of claim 8, wherein the step of harvesting (step iii) is followed by:
 - iv) isolating the heterologous protein from the transformed plant.
10. The method of claim 9, wherein the step of isolating (step iv)) is followed by a step of purification of the heterologous protein.
11. A method for production of a heterologous protein in a plant comprising,
 - i) providing a plant transformed with the construct of claim 3;
 - ii) growing the transformed plant; and
 - iii) harvesting the transformed plant to induce expression of the heterologous protein.

12. The method of claim 11, wherein the step of harvesting (step iii) is followed by:
iv) isolating the heterologous protein from the transformed plant.

13. The method of claim 12, wherein the step of isolating (step iv)) is followed by a step of purification of the heterologous protein.

14. A method for production of a heterologous protein in a plant comprising:

- i) providing a plant expressing the construct of claim 2;
- ii) growing the plant; and
- iii) harvesting the plant thereby inducing expression of the heterologous protein.

15. A method for production of a heterologous protein in a plant comprising,

- i) providing plant expressing the construct of claim 3;
- ii) growing transformed plant; and
- iii) harvesting the plant to induce expression of the heterologous protein.

16. A harvest inducible regulatory element according to claim 1, wherein the harvest inducible regulatory element is SEQ ID NO:4.

17. A harvest inducible regulatory element according to claim 1, wherein the harvest inducible regulatory element is SEQ ID NO:5.

18. A harvest inducible regulatory element according to claim 1, wherein the harvest inducible regulatory element is SEQ ID NO:6.

19. The plant, plant tissue, plant seed, plant cell, or progeny therefrom according to claim 6, wherein the plant, plant tissue, plant seed, plant cell, or progeny therefrom is selected from the group consisting of potato, tomato, canola, corn, soybean, alfalfa, pea, lentil, other forage legumes such as clover, trefoil, forage grasses such as timothy, ryegrass, brome grass, fescue or other cereal grasses used for forage such as barley, wheat, sudan grass, sorghum.

20. The plant, plant tissue, plant seed, plant cell, or progeny therefrom according to claim 7, wherein the plant, plant tissue, plant seed, plant cell, or progeny therefrom is selected from the group consisting of potato, tomato, canola, corn, soybean, alfalfa, pea, lentil, other forage

legumes such as clover, trefoil, forage grasses such as timothy, ryegrass, brome grass, fescue or other cereal grasses used for forage such as barley, wheat, sudan grass, sorgham.